

## REMARKS

The Non-Final Office Action mailed February 5, 2010 considered and rejected claims 1, 2, 5-10 and 53-60. Claims 9 and 59 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 2, 5-10 and 53-60 were rejected under 35 U.S.C. 103(a) as being obvious over BizTalk Server 2000 hereinafter *BizTalk*.

### 112 Rejections

Claims 9 and 59, which were rejected under Section 112, have been canceled.

### Obviousness Rejections

Each of the claims was rejected as being obvious in view of Microsoft's BizTalk Server 2000 product. Applicant traverses these rejections because neither BizTalk Server 2000 nor the references that describe it, constitute prior art under section 102.

This application was filed to cover features that were incorporated into the BizTalk Server 2000 product that was initially released to the public around April 2000 as indicated in the press release cited by the examiner. BizTalk Server 2000 was the first version of BizTalk Server released by Microsoft.

It is well established that "one's own work is not prior art under § 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a)." *In re Katz*, 687 F.2d 450, 454 (CCPA 1982). This is the case with the currently cited references. Each of the references describes the inventors' own work as embodied in Microsoft's BizTalk Server 2000. Accordingly, these references do not constitute prior art under § 102(a) and therefore cannot be used in an obviousness rejection.<sup>1</sup>

A portion of the inventors' disclosure for this application is being provided as support of Applicant's assertion that the inventors of the claimed subject matter are the same inventors that developed the same technology that appeared in BizTalk Server 2000. This disclosure states in Part 4 that the disclosed subject matter (i.e. the specification for this application) was incorporated into BizTalk Server 2000. Please note that a family tree is also being provided as support that this disclosure (which has a Microsoft patent ID of 81690976) is the disclosure for this application (which has a Microsoft patent ID of 81773742 and a Pat. Ref. # of 149613.02

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<sup>1</sup> It is also noted that, although the examiner has argued that the references are prior art under § 102(e), these references cannot be 102(e) art because they are not patent applications.

which falls under the patent ID 81690976). Please also note that the title of the disclosure is the same as the title of the invention.

As additional support, Applicant also submits that the cited references state that the claimed features of the invention were created for BizTalk Server 2000. For example, the BizTalk Orchestration reference, which was prepared after the priority date of this application on June 5, 2000, describes the long running transaction features of BizTalk Orchestration – a component of BizTalk Server 2000. The abstract of this reference states that its purpose is to describe what “motivated Microsoft’s creation of BizTalk Orchestration.” In this sense, when referring to Microsoft’s creation, what is meant is the creation by the individual inventors listed on this application.

In view of the above information, Applicant submits that the examiner’s requirement for information has been satisfied. Nevertheless, each individual requirement will be specifically addressed below.

In response to the requirement to provide the names of any products or services that have incorporated the claimed subject matter, Applicant submits that the cited references have already established that the claimed subject matter appears in BizTalk Server 2000. The disclosure also states the same.

In response to the requirement to state the specific improvements of the claimed subject matter over what is disclosed in the references, Applicant submits that there should not be any. The references each describe to some degree the invention as is currently being claimed.

In response to the requirement to provide any publications which any of the applicants authored or co-authored which describe the claimed subject matter, Applicant submits that various cited references already fulfill this requirement. As stated above, any description of BizTalk Server 2000 or its components such as BizTalk Orchestration necessarily describe the inventors’ own work. Therefore, these references would either have been authored by the inventors or derived from the work or writings of the inventors. If the examiner would like to review further documentation about BizTalk Server 2000, more information is available at <http://msdn.microsoft.com/en-us/library/aa286487.aspx>.

In response to the requirement to provide a citation of each publication relied upon to develop the disclosed subject matter, Applicant submits that all relevant references of which the inventors were aware were cited in the IDS filed on November 2, 2000. It is also again noted

that the claims cover features that were introduced in BizTalk Server 2000 – the first release of BizTalk Server. In other words, these features did not appear previously in any other product.

In conclusion, the claimed invention covers features of BizTalk Server 2000. These features were invented by the inventors listed in this application. Therefore, BizTalk Server 2000 and any reference describing it do not qualify as prior art under § 102(a). Applicant therefore submits that the current obviousness rejections are improper and requests that they be withdrawn. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (801) 533-9800.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; and/or (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

Dated this 4<sup>th</sup> day of May, 2010.

Respectfully submitted,

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